IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1944.

MINNESOTA MINING & MANUFACTURING COMPANY, Petitioner, vs. CONWAY P. COE, COMMISSIONER OF PATENTS	No. 738

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

MOTION FOR LEAVE TO FILE SECOND PETITION FOR REHEARING.

and

SECOND PETITION FOR REHEARING.

J. BERNHARD THIESS,
SIDNEY NEUMAN,
HAROLD J. KINNEY,
Counsel for Petitioner.

THE TWENTIETH CENTURY PRESS, INC., CHICAGO

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May it Please the Court:

Now comes the petitioner, Minnesota Mining & Manufacturing Company, by its counsel, and respectfully moves this Honorable Court for leave to file the annexed "Second Petition for Rehearing."

In support of this motion petitioner shows:

(1) In opposing the granting of the writ of certiorari in this case, respondent asserted (Brief for the Respondent in Opposition, p. 2) that "no question is properly presented here," and that petitioner had taken "no issue with any ruling of the District Court or the Court of Appeals."

(2) The foregoing assertion had no application whatsoever to question No. 4 set forth at page 4 of the petition for a writ of certiorari. Respondent did not even discuss that question. It is the only question now relied upon by petitioner and is the only one discussed in the

petition for rehearing which was denied on March 12, 1945.[1]

(3) It has been admitted by the respondent (Brief for the Respondent in Opposition, pp. 8-9) that the Court below affirmed the judgments of the District Court because there was here "no information as to the effect on the building trades of giving the plaintiff separate patent rights," citing *Monsanto Chemical Co.* v. *Coe* (App. D. C.), 145 F. (2d) 18. Respondent has also admitted that, under the *Monsanto* rule, an "applicant has the burden of proving * * * that the allowance of the rejected claims * * * would not give such control over the particular industry involved as to impede the progress of the art."

(4) There is thus admittedly presented in this case this important question of law which should be settled by this Court:

Is it a prerequisite to the grant of patents under the provisions of the present patent statutes that the applicant for patent must furnish either to the Patent Office or to the Federal courts having jurisdiction under Section 4915 R. S. (35 U. S. C., Sec. 63) evidence as to the industrial control and effect upon industry which the claims applied for will probably have?

(5) The case at bar presents a question which is a variant, *i. e.*, another major aspect, of the fundamental question now before this Court in *Special Equipment Co.* v. *Coe*, No. 469 of this term, which was argued on March 2, 5, 1945.

(6) The second petition for rehearing, annexed hereto, is meritorious and, together with the first petition for rehearing, adequately presents a question of great public importance, as well as an important question of patent law which ought to be settled by this Court.

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[1] Questions 1, 2, and 3 of the petition for a writ of certiorari were dropped by petitioner in its petition for rehearing (p. 5).

(7) A case which is believed to authorize the filing of a second petition for rehearing and to sustain the jurisdiction of this Court to grant its writ of certiorari on the basis of such petition, is *Cleveland Trust Company* v. *Schriber-Schroth Company,* 304 U. S. 587, *Id.* 305 U. S. 47.

WHEREFORE it is prayed that leave be granted petitioner to file its second petition for rehearing annexed hereto.

J. BERNHARD THIESS,
SIDNEY NEUMAN,
HAROLD J. KINNEY,
Counsel for Petitioner.

The undersigned counsel for petitioner hereby certifies that the foregoing "Motion for Leave to File Second Petition for Rehearing" is believed to be well founded in law and in fact, and that it is not interposed for the purpose of delay.

J. BERNHARD THEISS.

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SECOND PETITION FOR REHEARING.

To the Honorable Harlan Fiske Stone, Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

The above named petitioner presents this its second petition for rehearing, and in support hereof shows:

1. The original petition for a writ of certiorari was filed in this Court on December 8, 1944.

2. By order of this Court entered on January 15, 1945, the prayer of the said petition was denied.

3. After enlargements of the time therefor were duly obtained, a petition for rehearing was filed in this Court on March 9, 1945.

4. By order of this Court entered on March 12, 1945, the said petition for rehearing was denied.

5. Every reason which was advanced by the petitioners

in *Special Equipment Company* v. *Coe*[1] and *Hoover Company* v. *Coe*[2] for the granting of the writs in those cases also exists in this case. If the nature of the questions presented in those cases moved this Court to grant the writs, the single question now involved in this case must, with stronger reason, similarly influence the Court.

6. The single question to which the consideration of the Court in this case may be limited, if it shall please this Court to grant its writ of certiorari, involves a variant or another major aspect of the same fundamental question which is presented in the *Special Equipment* case, *i. e.,* the *motive* of a patent owner and the use to which he intends to put his invention and patent. In the *Special Equipment* case, the variant is concerned with a lack of intention to use; in this case, the variant is concerned with actual intended use and the degree of control over competition which the patentee intends to exert.

7. If the question involved in the case at bar is decided according to petitioner's views, this Court will accomplish a complete practical settlement of the fundamental and related questions of patent law involved in this and the *Special Equipment* and *Hoover* cases.

Where cases have presented related questions of law this Court has frequently issued its writ of certiorari to review all of them in order to secure uniformity of decision and practice. *Fashion Originators' Guild* v. *Federal Trade Commission,* 312 U. S. 457, and *Millinery Creator's Guild, Inc.* v. *Federal Trade Commission,* 312 U. S. 469; *Crown Cork & Seal Co.* v. *Ferdinand Gutmann Co.,* 304 U. S. 159, and *General Talking Pictures Corp.* v. *Western Electric Co.,* 304 U. S. 175; *McCandless* v. *Furlaud,* 292 U. S. 617,

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[1] No. 469 of this term, which was argued on March 2, 5, 1945.
[2] No. 486 of this term, which was argued on March 5, 1945.

Id., 293 U. S. 67, and *Mitchell* v. *Maurer*, 293 U. S. 237, 544.[3]

The case at bar is one of a group of appeals lately pending in the United States Court of Appeals for the District of Columbia which had been taken to that Court in actions brought in the United States District Court of that district pursuant to the provisions of Section 4915 R. S. which confers upon persons seeking patents the right to secure in a court of equity an independent judicial review of the action of the United States Patent Office in refusing a patent to them. In addition to the case at bar, these cases were:

Special Equipment Co. v. *Coe* (App. D. C.), 144 F. (2d) 497.

Hoover Company v. *Coe* (App. D. C.), 144 F. (2d) 514.

Colgate-Palmolive Peet Co. v. *Coe* (App. D. C.), 144 F. (2d) 517.

Line Material Co. v. *Coe* (App. D. C.), 144 F. (2d) 518.

Monsanto Chemical Company v. *Coe* (App. D. C.), 145 F. (2d) 18.

Apparently regarding this group of cases as suitable media for the introduction of wholly novel statutory constructions and doctrinaire reforms, the Court below, in affirming the decrees of the District Court, took advantage of the occasion to announce these important rulings:

(a) In *Hoover Company* v. *Coe; Colgate-Palmolive Peet*

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[3] This Court's practice where the cases involve points identical with, or variants of, questions already before the Court is further illustrated by *General Motors Acceptance Corp.* v. *United States*, 286 U. S. 49; *United States* v. *The Ruth Mildred*, 286 U. S. 67; *General Import & Export Co.* v. *United States*, 286 U. S. 70; *United States* v. *Commercial Credit Co.*, 286 U. S. 63, and *United States* v. *Corriveau*, 286 U. S. 530.

Co. v. *Coe*, and *Line Material Co.* v. *Coe*[4] the Court below, contrary to a practice of long standing, refused to assume jurisdiction of actions under Section 4915 where the applicants, desiring to contest interferences with previously granted unexpired patents, had copied claims from those patents and were seeking an independent judicial review by the Federal Courts of the action of the Patent Office in holding that the applicants did not have the right to make the copied claims.[5]

(b) In *Special Equipment Company* v. *Coe*, the Court below held that patent claims should be denied to a patent applicant on the ground that where there was a lack of intention on the part of the applicant to use the claimed structure which was a novel part of the whole machine, the issuance of a patent therefor would constitute a misuse of the statutory patent privilege; and

(c) In *Monsanto Chemical Company* v. *Coe* and in *this case*, the Court below held that patent claims may be withheld from an applicant when he has not furnished evidence as to the degree of industrial control which he hopes to gain by means of his claims "over competing industry and competing invention," *e.g.*, the probable economic impact of the patent, if granted, upon a particular industry.

Each of these rulings was unprecedented. Each was without statutory warrant and each was in conflict with well established applicable decisions of this Court. It is difficult to perceive that the first and second rulings or either of them can be more important than the third ruling.

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[4] The Petition for a Writ of Certiorari in the *Line* case (No. 665 of this term) was filed on November 11, 1944, but no disposition thereof has been made.

[5] Petitioner's counsel understand that in his brief, and on the oral argument in this Court, the respondent, in the *Hoover* case, confessed the error of this ruling.

Referring to the *Special Equipment* and *Monsanto* decisions,[6] as the "Arnold opinions," the Honorable V. I. Richard, a member of the Board of Appeals, United States Patent Office, has called attention to the "considerable comment"[7] aroused by the opinions in this "series of cases • • • because of the novelty of their approach to the patent questions considered." *Journal of the Patent Office Society*, Vol. XXVII, pp. 28-30. Although Mr. Richard stated that these decisions "merely affirmed the District Court for refusing a patent and thereby affirming the Patent Office," he admitted, and very significantly observed, that "It was the reasoning in the opinions that was startling."[8]

If, as seems to be inevitable because of the confession of error in the *Hoover* case, this Court shall reverse the Court below in that case, a full and complete settlement of the jurisdictional, substantive and procedural questions, governing actions under Section 4915 R. S., will not be accomplished unless certiorari is granted in the case at bar. Applicants for patents will still be required to submit to and comply with the *Monsanto* rule adopted by the Court below, and they will be required to supply evidence in the light of the industrial facts (adduced from their competitors) as to the "amount of control that should be

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[6] Together with *Potts* v. *Coe* (App. D. C.), 140 F. (2d) 470, with which we are not here concerned.

[7] See for example: "The Slamming of the 4915 Door." *Journal of the Patent Office Society*, Vol. XXVI, pp. 651-663.

[8] The "new approach" reported by Mr. Richard as permeating all of the opinions is: " • • • applications belonging to corporations were appraised from the standpoint of what effect the grant of a patent would have in strengthening the position of its corporate owner in a competitive field. Superimposed on the questions ordinarily considered was the paramount question: Could a patent be misused if it were granted?"

On the other hand, as pointed out by Mr. Richard, the Court of Customs and Patent Appeals has refused to assume that there is a "new doctrinal trend" as to the standards of patents, holding that "the creation of new standards for the determination of what constitutes invention would be judicial legislation and not judicial interpretation." *In re Shortell* (C. C. P. A. April 4, 1944), 142 F. (2d) 292, 296.

allowed to the inventor as his reward," before being entitled to their patents. If that rule is erroneous, as we have shown it to be in our petition for rehearing, then, obviously, a reversal of the *Hoover* case only, will not provide full and adequate relief.

Nothing in a practical or realistic sense will be settled by a holding that the Court below has jurisdiction when that Court is left with its decision in the *Monsanto* case which is the full equivalent of the right to decline jurisdiction. That decision will continue to be controlling in the Court below unless reviewed and reversed by this Court. This is plainly shown by the recent invocation and application of the questioned rule in *F. J. Stokes Mach. Co.* v. *Coe* (App. D. C., decided Jan. 22, 1945), 64 U. S. P. Q. 203.

Hence, the doctrine here involved is equally as important as those involved in the *Hoover* and *Special Equipment* cases. In order to secure a review by this Court of all of the rulings, adversely affecting the constitutional and statutory rights of inventors, which have been made by the Court of Appeals for the District of Columbia, it is urgent that certiorari be granted in this case.

CONCLUSION.

The main claims here in question are already extant in the patent of another and later applicant, and enjoy a strong presumption of validity. Petitioner which practices the invention in the manufacture of large quantities of the special colored coated granules is nevertheless being denied its right to contest priority. It has no adequate remedy save through the writ here sought. Even the right to a declaratory judgment (which would not, however, be an adequate remedy) does not exist.

Counsel recognize that this Court should not be burdened with ordinary cases, and they are aware also that it is presumptuous to seek certiorari, especially by a second petition for rehearing, unless there are present questions of a fundamental nature and of great moment requiring the exercise by this Court of its supervisory power of review. It is felt that such a question is present and that this second petition is justified in asking this Court to reconsider its denial of the first petition for rehearing[9] and upon such reconsideration vacating the order denying the petition for a writ of certiorari and awarding the writ.

Respectfully submitted,

J. Bernhard Thiess,
Sidney Neuman,
Harold J. Kinney,
Counsel for Petitioner.

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[9] In addition to the authority of *Cleveland Trust Co.* v. *Schriber-Schroth Co.*, cited in the motion, ante p. 3, see *Massey* v. *United States*, 291 U. S. 608, 655-6, where the writ was granted upon petition for rehearing and consideration limited to the question raised by that petition. *Cf.* also *Brinkerhoff-Faris Co.* v. *Hill*, 280 U. S. 550, and *Exhibit Supply Co.* v. *Ace Patents Corp.*, 314 U. S. 702.

CERTIFICATE OF COUNSEL.

The undersigned counsel for petitioner hereby certifies that the foregoing second petition for rehearing is presented in good faith and not for delay.

J. Bernhard Thiess.